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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/874,185 | 06/04/2001 | Hitoshi Hidaka | 7005-002 | 5613 |

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| EXAMINER | |
|---|---|
| LINNENKAMP, NICHOLAS L | |
| ART UNIT | PAPER NUMBER |
| 2635 | |

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/874,185 | HIDAKA ET AL. | |
| | Examiner | Art Unit | |
| | Nicholas L Linnenkamp | 2635 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *06 August 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *6/4/2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "780" has been used to designate both a "counter" and a "communication tag" as seen on Fig 7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 682, 684, 782, 784, 786, 790, 792, and 774. It is understood that some of these reference signs generally correspond to like components in other drawings but such reference signs must clearly indicate what they correspond with (for example, "A, B, and C in Fig 4, correspond to D, E, and F in Fig 7, respectively"). A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 2, 5, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Yabuki.

In reference to claim 1, Yabuki teaches of an article identifying system that includes communication tags (50) for attachment to an article, and an information output device (410). Yabuki teaches that each communication tag transmits over RF a unique identifier (Col 3, lines 60-62), and that the information output device has a storage means (418) for retrieving related information data associated with transmitted identifier. Yabuki teaches that information output device has first receive means (413), information reading means for reading the information from data base (411), and output information means (414, 415).

In reference to claim 2, Yabuki teaches of information data that is voice data corresponding to article identifier (415, Col 5, lines 12-13).

In reference to claim 5, Yabuki teaches that the information data associated with the object is graphic data (414, Col 6, lines 38-40).

In reference to claim 13, Yabuki teaches of preparing a communication tag, attaching it to an article, and having each tag store an identifier assigned to the article with the tag (Col 1, line 67; Col 2, line 1). Yabuki teaches of preparing an information output device (410) that stores information data related to the article (Col 6, lines 32-34), so that the information data is associated with the identifier (Col 6, lines 34-38), and comprises an information output means for outputting the information data (Col 6, lines 38-40). Yabuki teaches of receiving the identifier from the tag when the tag is placed in the communication area of the information output device, reading the information data associated with the identifier (Col 6, lines34-38) and outputting the read information data (Col 6 lines 38-40).

Thus, Yabuki teaches all the limitations of claims 1, 2, 5, and 13.

5. Claims 7, 8, and 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Dvorak.

In reference to claim 7, Dvorak teaches of an article identifying and tracking system (Abstract) in which communication tags (Col 3, lines 40-42) that transmits identification information. Dvorak teaches of an information output device (100) for storing information data related to the article (160, 162) along with a receiving means

(120) for obtaining identifiers and storing identifiers. Dvorak teaches of detecting removal of one of the items from the communication range of the information output device (Col 3, lines 21-29) and outputting the information data (Col 4, lines 8-12).

In reference to claim 8, Dvorak teaches that information data identifies object through audio output device (154).

In reference to claim 11, Dvorak teaches that the tracking device for issuing an alert could be incorporated into a Personal Digital Assistant (PDA) (Col 4, lines 17-20). PDA's at the time of invention would include display elements for interaction with the device.

Thus Dvorak teaches all the limitations of claims 7, 8, and 11.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 3, 4, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yabuki in view of Tuttle et al. (heretofore Tuttle) further in view of Tarlow et al. (heretofore Tarlow).

In reference to claim 3, Yabuki teaches all the limitations of claims 1-2 as shown above. Yabuki remains silent as to how voice data is obtained, and the transmission of identifiers to communications tags. Tuttle suggests the use of a programmable RFID tag so that the user can specify identification number to the communication tag (Col 2, lines 39-44). Tarlow suggests the use of a removable module for recording/rerecording voice information in a data storage area (Abstract)

In reference to claim 4, Yabuki, Tuttle, and Tarlow teach claim 3 as above. Yabuki teaches the use of a control unit (41) described as being a computer (411, Col 5, lines 42-43). The user of Yabuki's device could select the identifier to be any value preferred including a value to correspond to a counter in the computer.

In reference to claim 6, Yabuki, Tuttle, and Tarlow teach claim 4 as above. Yabuki teaches of a plurality of information output terminals (Col 3, lines 1-3) that can communicate through a network (32, 31, 17).

It would have been obvious to one skilled in the art at the time of invention to combine the teachings of Yabuki with the suggestions of Tuttle and Tarlow because Yabuki discloses the need for RFID tags as labels (Col 3, lines 66-67; Col 4, lines 1-2) and the need to assign the same ID number to similar articles (Col 3, lines 52-57), while Tuttle suggest that his RFID tag is useful as a label (Abstract) and that the tag is ID programmable. In addition, Yabuki describes the need to output voice data but does

not disclose a method on voice data capture, while Tarlow provides a method for voice capture. Thus, the teaching of Yabuki along with the suggestions of Tuttle and Tarlow render obvious the limitations of claim 3, 4, and 6.

7. Claims 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dvorak in view of Tuttle.

In reference to claim 9, Dvorak teaches claim 8 as above. Dvorak teaches that the information output device has a voice record means (152) for specifying the corresponding article, storage means for storing identifier (160). Dvorak does not teach of transmitting ID to device. Tuttle suggest the use of a programmable RFID tag for use in identification and tracking systems (Abstract).

In reference to claim 10, Dvorak and Tuttle teach claim 9 as above. Dvorak teaches the use of a controller (110) for retrieving and executing commands and programs from memory (160). The user of Dvorak's device along with the programmable RFID tag of Tuttle could select any ID including one associated with a counter.

It would have been obvious to one skilled in the art at the time of invention to use the RFID tag of Tuttle in the device of Dvorak because Dvorak teaches the use of generic RF tags and Tuttle suggest that his device, which can be programmed with identification information, be used in identification and tracking systems.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dvorak in view of Tuttle further in view of Yabuki. Dvorak and Tuttle teach claim 10 as above. Dvorak teaches of information output terminals such as PDA's for use in inventory identification and tracking but remains silent as to connecting them through a network. Yabuki teaches of a plurality of information output terminals (Col 3, lines 1-3) for use in inventory identification that can communicate through a network (32, 31, 17). It would have been obvious to one skilled in the art at the time of invention to combine the teachings of Dvorak and Tuttle with the suggestions of Yabuki because both Dvorak and Yabuki teach inventory identification methods and Yabuki discloses the need for facilities to sort information (Col 1, lines 20-24) such as the method disclosed by Dvorak.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yabuki in view of Dvorak. Yabuki teaches the limitations of claim 13 which are similar to that of claim 14. Yabuki remains silent as to the steps of storing the one or more received identifiers, detecting difference between one or more identifiers and those received just before, and reading the information data associated with the identifiers of the detected difference. Dvorak suggests the use of an item coupling system and method (Abstract). Dvorak suggests storing information of received identifiers (520), detecting difference between identifier and the one received before (540), and reading information data associated with the identifier of the detected difference (540). It would have been obvious by one skilled in the art at the time of invention to combine the teachings of

Yabuki with the suggestions of Dvorak because both Dvorak and Yabuki teach inventory identification methods and Yabuki discloses the need for facilities to sort information (Col 1, lines 20-24) such as the method disclosed by Dvorak.

10. Additional reference material by Kruest, labeled "Cloaking circuit for use in a radiofrequency identification and method of cloaking RFID tags to increase interrogation reliability" was included because Yabuki's device exposed a limitation of not being able to read multiple tags in close proximity together. Kruest's device allows for multiple tags to be in close proximity and still function without appreciable interference and which would have been within the scope of Yabuki's device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas L Linnenkamp whose telephone number is (703) 305-8701. The examiner can normally be reached on 8:00-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (703) 305-4704. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

Nicholas L Linnenkamp
Examiner
Art Unit 2635

MICHAEL HORABIK
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NLL